

## REMARKS

Applicants appreciate the thorough review of the present application as reflected in the Official Action mailed June 3, 2004. For the reasons discussed below, Applicants submit that the present application is allowable over the cited references.

### **The Objections to the Claims**

Claims 3, 24 and 25 are objected to because of informalities. Applicants have amended Claim 3 to recite selectively linking at least two of the selected generic definitions. Applicants have also amended Claim 24 to depend from Claim 21 and Claim 25 to depend from Claim 22 as suggested by the Examiner.

### **The Section 112 Rejection**

Claims 3, 22, 24 and 37 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As discussed above, Applicants have amended Claim 24 to depend from Claim 21 and, therefore, Applicants submit that antecedent basis is provided for each of the recitations of Claim 24.

Applicants have also amended Claims 3, 22 and 37 to recite that at least two of the selected generic definitions are linked. Linking of generic definitions is described, for example, with reference to Figure 9 and at pages 24 and 25 of the present specification. Accordingly, Applicants submit that the recitations of Claims 3, 22 and 37 are not indefinite as these claims now recite that at least two of the selected generic definitions are linked.

In light of the above discussion, Applicants submit that the rejections under 35 U.S.C. § 112 have been overcome.

### **The Claims Are Not Anticipated**

Claims 1-5, 20-24 and 35-39 stand rejected under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 6,202,155 to Tushie *et al.* (hereinafter "Tushie"). Applicants have amended Claims 1, 20 and 35 to incorporate the recitations of Claims 6, 25 and 40 respectively, without the recitations of intervening claims. Applicants submit that the recitations of Claims 6, 25 and 40 are not disclosed by Tushie. Accordingly, Applicants submit that the rejections of Claims 1-5, 20-24 and 35-39 under 35 U.S.C. § 102 have been obviated.

**The Claims Are Not Obvious**

**The Rejection of Claims 6-15, 25-34 and 40-49**

Claims 6-15, 25-34 and 40-49 stand rejected as obvious under 35 U.S.C. § 103 as obvious in light of Tushie. As discussed above, Applicants have amended Claims 1, 20 and 35 to incorporate the recitations of Claims 6, 25 and 40 respectively, without the recitations of intervening claims. Accordingly, Applicants will address the rejection of Claims 6, 25 and 40 with reference to amended Claims 1, 20 and 35.

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczaik*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also

explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). As discussed in further detail below, Applicants submit that the Official Action has failed to establish a prima facie case of obviousness as the cited references do not disclose or suggest each of the recitations of the claims and a proper motivation to combine the references has not been established.

In rejecting Claims 6-15, 25-34 and 40-49, the Official Action does not cite to any reference as teaching the recitations added by these claims but simply states that Tushie teaches that the product card definition "is not limited to only the definitions that are disclosed." Official Action, p. 5. From this, the Official Action concludes that "using other types of definitions as claimed would be obvious to one having ordinary skill in the art." Official Action, p. 5. Applicants submit that the Official Action has failed to establish a prima facie case of obviousness at least because the Official Action does not identify where in the art each of the recitations of the claims may be found or why one of skill in the art would be motivated to modify the cited reference to result in the specific recitations of the rejected claims.

For example, amended Claim 1 recites, in part, "associating at least one enterprise definition with the instance of the card product definition." Nothing in Tushie suggests such the use of an enterprise definition. In fact, Applicants submit that Tushie does not contemplate the use of definitions that provide for management of smart card products beyond the fabrication of the cards themselves. For example, the system of Tushie appears to concerned with producing cards, not managing their production and use. *See Tushie, Abstract.* Thus, Applicants submit that there would be no reason to modify the objects of Tushie to include card management objects, such as the enterprise definition. Merely because Tushie suggests that other objects could be created does not suggest the specific recitations of amended Claim 1. Corresponding arguments may be made with respect to Claims 20 and 35. Accordingly, Applicants submit that Claims 1, 20 and 35, and the claims that depend from them, are patentable over Tushie.

While each of the dependent claims is patentable as depending from a patentable base claims, Applicants submit that certain of the claims are separately patentable over Tushie. For example, Claim 10 recites "associating a hot list

definition with the instance of the card product definition." Corresponding recitations are found in Claims 30 and 45. Applicants submit that Tushie does not disclose or suggest the hot list of Claims 10, 30 and 45 as the Official Action has not pointed to any prior art reference that teaches these recitations nor has a convincing line of reasoning been provided as to why Tushie would be modified to include these specific recitations.

Claim 15 recites "associating an enterprise definition with the at least one process definition if the at least one process definition utilizes resources of an enterprise outside the domain of a smart card management server" and "associating a connection definition with the at least one process so as to define a mechanism for establishing a connection between the smart card management server and an enterprise associated with the enterprise definition associated with the at least one process definition." Corresponding recitations are found in Claims 34 and 49. The cited portions of Tushie do not address the possibility of distributing resources in smart card management outside of a single enterprise. Thus, Applicants submit that Tushie does not disclose or suggest the recitations of Claims 15, 34 and 49, which address the utilization of resources outside the domain of a smart card management server.

#### The Rejection of Claims 16-18

Claims 16-18 stand rejected under 35 U.S.C. § 103 as obvious in light of Tushie in view of United States Patent No. 6,735,593 to Williams (hereinafter "Williams") and further in view of United States Patent No. 6,402,028 to Graham, Jr. *et al.* (hereinafter "Graham"). Applicants have amended Claim 16 to incorporate the recitations of Claim 17 and, therefore, will address the rejection of Claim 17. In rejecting Claim 17, the Official Action acknowledges that Tushie does not disclose the recitations of Claim 17 but does not cite to any reference as teaching these recitations. Official Action, pp. 6-7. Instead, the Official Action states that Tushie teaches that the product card definition is not limited to only the definitions that are disclosed and from this, concludes that "using other types of definitions as claimed would be obvious to one having ordinary skill in the art." Official Action, pp. 6-7. However, merely stating that other objects could be used does not disclose or suggest the specific recitations of Claim 16. For example, Applicants submit that the Official Action has failed to establish a *prima facie* case of obviousness because the

Official Action does not identify where in the art each of the recitations of the claims may be found or why one of skill in the art would be motivated to modify the cited reference to result in the specific recitations of the rejected claims. For example, Claim 16 recites the enterprise definition and its use. As discussed above with reference to Claims 1 and 15, Tushie does not suggest such an enterprise definition or its use. Thus, amended Claim 16 is patentable over the cited references for reasons analogous to those discussed above with reference to Claims 1 and 15. Applicants submit that the claims that depend from Claim 16 are patentable at least as depending from a patentable base claim.

The Rejection of Claim 19

Claim 19 stands rejected under 35 U.S.C. § 103 as obvious in light of Tushie Williams, Graham and United States Patent No. 6,401,203 to Eigeles (hereinafter "Eigeles"). Applicants submit that Claim 19 is patentable at least as depending from a patentable base claim.

Conclusion

In light of the above discussion, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.

It is not believed that an extension of time and/or additional fee(s)-including fees for net addition of claims-are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 09-0461.

Respectfully submitted,



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